

Serial No. 09/882,788
Filed: M 6675

Docket M 6675

The claims are directed to an article of manufacture that is defined by its physical elements as recited in claim 1, following the transition in the claim. As the P.T.O. so frequently points out, statements of intended use in the preamble are not substantive limitations in a claim. Therefore, one of skill would ignore them in assessing the scope of applicants' claims (as the examiner also, correctly, did). Words that define no element of the invention cannot render a claim indefinite. 'Shelf liner' could as easily be 'widget' and (the written description issue notwithstanding) not alter the scope of the claim a whit. But applicants wonder - can it be argued seriously that one of skill in the art of this product would not understand what a shelf liner is? Does the examiner require an affidavit on this issue?

35 U.S.C. § 103

Claims 1, 3-10, 12, 16, and 17 are rejected as obvious over U.S. 4,151,319 (Sackhoff) in view of U.S. 4,783,154 (Fagan), U.S. 6,025,058 (Shepherd), and U.S. 3,808,091 (Aoki). Claims 2, 11, and 13 are rejected as obvious over Sackhoff in view of Fagan, Shepherd, and Aoki, and further in view of U.S. 4,623,587 (Ito). Lastly, claims 14 and 15 are rejected over Sackhoff in view of Fagan, Shepherd, and Aoki, and further in view of U.S. 4,947,999 (Warp). Applicants respectfully traverse these rejections together.

It is well settled that references can be combined to show *prima facie* obviousness only where there is an objective motivation or suggestion in the art to make the alleged combination. As to Aoki, applicants do not deny that it describes a method of making synthetic paper. But neither Aoki, nor Sackhoff, nor the other references, suggest the substitution of Aoki's synthetic paper for the facing layer materials

Serial No. 09/882,788
Filed: M 6675

Docket M 6675

described for in the Sackhoff laminate at col. 7 line 62 to col. 8, line 5.

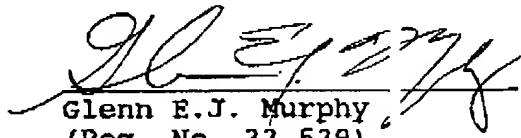
As to the synthetic paper of Shepherd, the reference itself provides *disincentive* to use the material in applicants' shelf liner. As set forth in applicants' background in the specification, applicants' sought a less absorptive material to replace natural fiber paper. By contrast, it is a stated objective in the Shepherd disclosure to provide a material having superior absorption properties. Thus one of skill would not have been motivated to combine Shepherd with Sackhoff as alleged.

For these reasons the claims are allowable over the art of record. Continued examination and allowance are earnestly solicited.

CONCLUSION

Should any fees be due for entry and consideration of this Amendment that have not been accounted for, the Commissioner is authorized to charge them to Deposit Account No. 01-1250.

Respectfully submitted,


Glenn E.J. Murphy
(Reg. No. 33,539)
Attorney for Applicants
(610) 278-4926

Henkel Corporation
Patent Law Department
2500 Renaissance Blvd., Suite 200
Gulph Mills, PA 19406